

REMARKS

The applicant has carefully considered the official action dated December 19, 2005 and the cited references. In this application, claims 17-27 and 55-58 are pending and at issue, of which claim 17 is independent. In the official action, claims 17-27 and 55-58 were rejected under 35 U.S.C. § 102(b) as anticipated by Dotta. The applicant has amended claim 17 to incorporate the limitations of dependent claims 18, 19, and 21 to clarify the scope of protection sought and has canceled claims 18-21 without prejudice. No new matter has been added. By way of this response, the applicant respectfully traverses the rejections and respectfully submits that all pending claims are in condition for allowance. Favorable reconsideration is respectfully requested.

The applicant respectfully submits that independent claim 17 is allowable over the art of record. Independent claim 17 is directed to a rotary press apparatus that includes, *inter alia*, a first ram and a second ram, a first cutting tool member coupled to the first ram, and a second cutting tool member coupled to the second ram, wherein the first and second cutting tool members comprise a cut-off blade and ram set. The art of record fails to teach or suggest first and second cutting tool members comprising a cut-off blade and ram set as recited in claim 17. Dotta teaches an upper die (1) having female tools or matrixes (3) and a lower die (2) having male tools or punches (4). However, Dotta does not teach that the upper and lower dies (1) and (2) have or can have a cut-off blade and ram set. Therefore, Dotta cannot anticipate independent claim 17 because Dotta does not teach each and every element recited in independent claim 17.

In addition, the applicant respectfully submits that it would not have been obvious to one of ordinary skill in the art at the time of the invention to modify the Dotta punching

device to have a cut-off blade and ram set because such a modification would change the principle of operation of the Dotta punching device. The law is quite clear that, “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention, then the teachings of the references are not sufficient to render the claims prima facie obvious.” MPEP § 2143.01 (citing *In re Ratti*, 270 F.2d 810, 813 (C.C.P.A. 1959)). In *In re Ratti*, the claims were directed to an oil seal comprising “...a sealing ring ... of resiliently deformable material...” 270 F.2d at 810 (citing *Ratti* application, claim 10). The prior art reference relied upon by the examiner described a “‘stiffened’ sealing member.” *Id.* at 811 (emphasis in original). The court held that replacing the stiffened sealing member in the prior art reference with a resiliently deformable material was not a proper line of reasoning to support a prima facie rejection because, “[it] would require a substantial reconstruction and redesign of the elements shown in [the prior art reference] as well as a change in the basic principles under which the [prior art reference] construction was designed to operate.” *See Id.* at 813. Accordingly, the court reversed the examiner’s obviousness rejection.

Here, Dotta describes a particular configuration for the punch and matrix tool assemblies (3) and (4) to provide satisfactory operation that is immune to “play” between toothed wheels (9) and (109). *See Dotta*, col. 2, ll. 36-40 (“ensure satisfactory operation of the described device even in case of slight play between the toothed wheels 9 and 109 and tolerances in the construction and mounting of the various parts forming the device”). Dotta teaches mounting the punches (4) in the die (2) for “axial laterally sealed movement” to enable the punches (4) to shift transversely so that the punches (4) and matrixes (3) need not be accurately aligned before starting operation. *See Id.*, col. 2, ll. 40-43. Dotta also teaches providing a water-tight chamber (16) filled with water that interconnects the punches (4) by a

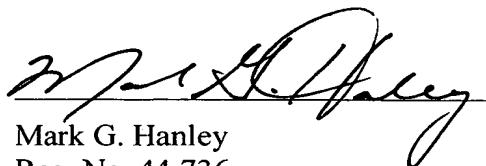
hydrostatic connection. *See Dotta*, col. 2, ll. 46-62. The hydrostatic connection enables the punches (4) of different lengths to adapt their protrusion from the die (2) to operate correctly with the matrixes (3).

Any proposal to modify the Dotta punching device by replacing the punch and matrix tool assemblies (3) and (4) with the cut-off blade and ram set recited in claim 17 would change the principle of operation of the Dotta punching device. For example, replacing the Dotta punches (4) with a cut-off blade would obviate the need for the hydrostatic connection associated with the Dotta punches (4) and, thus, eliminate the hydrostatic connection. Dotta describes the hydrostatic connection as an advantage of the Dotta invention because it enables punches of different lengths to adjust to the matrixes (3) of an opposing die. *See Id.*, col. 2, ll. 58-68 and col. 3, ll. 1-8. The applicant respectfully submits that eliminating the hydrostatic connection would change a principle of operation of the Dotta punching device. Therefore, it would not be *prima facie* obvious to modify the Dotta punching device by replacing the matrix and punch tool assemblies (3) and (4) with the cut-off blade and ram set recited in claim 17. Accordingly, the applicant respectfully submits that independent claim 17 and all claims dependent thereon are in condition for allowance.

In view of the foregoing, the applicant respectfully requests an early favorable action on the merits. If there are any remaining matters that the examiner would like to discuss, the examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,

Dated: **June 19, 2006**

A handwritten signature in black ink, appearing to read "Mark G. Hanley", written over a horizontal line.

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